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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,810	12/31/2003	Werner Holzl	HM/5-21810/A/PCT/DIV	1623

324 7590 04/22/2005

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,810

Applicant(s)

HOLZL ET AL.

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18 and 19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/762,008.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-12-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

First Office Action on the Merits

Election/Restrictions

1. Applicant's election with traverse of Group II claims 18 and 19 in the reply filed on October 8, 2004 is acknowledged. The traversal is on the ground(s) that the restriction is between product and process claims. This is not found persuasive because as stated by applicant, restriction between product and process claims is permitted. Also as noted by applicant and stated by the examiner in the Office Action dated September 13, 2004, when a product claim is found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowed product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

The requirement is still deemed proper and is therefore made **FINAL**.

Status of the Application

2. Claims 11-19 are pending in the present application. Claims 11-17 stand withdrawn from further consideration as being drawn to a nonelected invention. Claims 18 and 19 are rejected as indicated below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muehlbauer et al. (GB 1079348) and Kaminski et al. (US 4,115,588) or Lang et al. (US 4,772,689) or Blank (US 4,847,088) in combination.

Muehlbauer et al. teaches oxathiazole derivatives, such as 5-methyl-1,3,4-oxathiazol-2-one and 5-(chloromethyl)-1,3,4-oxathiazol-2-one, and their fungicidal property (see the entire article, especially page 3, lines 7-14; Examples 1-3 and 9; claims 13-16).

Each of Kaminski et al., Lang et al. and Blank teaches that it is known in the art to incorporate fungicidal agents into various compositions including cosmetic preparations such as mouthwashes, shampoos, soaps etc. (see '588, col. 17, lines 25-37; '689, col. 3, lines 40-44; '088, col. 1, line 11 – col. 2, line 37) to prevent contamination and deterioration of said products.

Based on the teachings of the prior art and the level of skill of the ordinary artisan in the cosmetic art, it would have been obvious to the skilled artisan at the time of the present invention to utilize the oxathiazole derivatives taught by Muehlbauer in the compositions taught by Kaminski, Lang and Blank with the reasonable expectation of preventing the contamination and deterioration of said compositions. The motivation would be based on (a) the teachings of Muehlbauer that said oxathiazole derivatives have fungicidal properties and (b) the knowledge in the cosmetic art that antimicrobial agents prevent contamination and deterioration of cosmetic products.

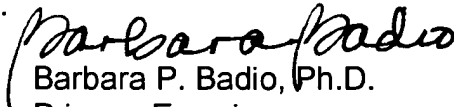
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Telephone Inquiry

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Barbara P. Badio, Ph.D.
Primary Examiner
Art Unit 1617

BB
April 19, 2005